



**IN THE
UNITED STATES
PATENT AND TRADEMARK OFFICE**

IN RE APPLICATION OF: Shawn O'Neal

CASE: 70445.010100

SERIAL NO.: 10/774,223

FILED ON: February 6, 2004

FOR: LID FOR BEVERAGE CONTAINERS

**RESPONSE TO
OFFICE ACTION**

EXAMINER: Robin Annette Hylton

ATTENTION OF: Art Unit 3727

COMMISSIONER OF PATENTS
Alexandria, VA 22313.1450

Dear Sir:

If any charges or fees must be paid in connection with the following communication, they may be paid out of our Deposit Account No. 502428.

This is in response to the Office Action imposing a Restriction Requirement in connection with the above-captioned application, which Restriction Requirement was mailed on December 2, 2005.

In the Restriction Requirement, the Examiner asserts that the application contains the following distinct inventions:

Group I illustrating the lid in Figures 1-7,

Group II illustrating the lid in Figures 8-11,

Group III illustrating the lid in Figures 12-14, and

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Group IV illustrating the lid in Figures 15-17.

The Examiner has required that the further prosecution of this application be restricted to only one of these several embodiments, with the further prosecution of the non-elected embodiments taking place, if at all, in a divisional application to be filed in the future.

Applicant respectfully traverses the Examiner's restriction requirement. There are two criteria for a proper restriction requirement between patentably distinct inventions:

(A) The inventions must be independent or distinct as claimed; and

(B) There would be a serious burden on the examiner if restriction is not required.

(MPEP § 803.) "If the search and examination of all claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions." (MPEP § 803.)

The Examiner is required to provide reasons and/or examples to support each of the two required conclusions in order to make a proper restriction requirement. (MPEP § 803.) A *prima facie* showing of serious burden on the examiner requires an appropriate explanation of separate classification or different fields of search that would be required for each of the purportedly independent and distinct inventions. (MPEP § 803.)

In this case, the Examiner has made no showing whatsoever as to any burden at all, much less a serious burden to the Examiner, if restriction is not required. Absent a

prima facie showing of serious burden, the restriction requirement cannot be properly maintained.

The embodiments identified by the Examiner as distinct inventions all relate to the single narrow field of a cup lid having a second means of attachment to a cup for purposes of temporarily storing the lid. Thus, Applicant respectfully submits that all of Applicant's claims can be readily searched and examined by the Examiner without serious burden. Accordingly, the restriction requirement should be revoked.

However, should the Examiner persist in maintaining the restriction requirement, and in order to provide the required complete response to the Office Action, Applicant provisionally elects Group I with traverse, for continued prosecution in the present application. While the Examiner has not identified which claims purportedly correspond to Group I, Applicant submits that the species illustrated in Figures 1-7 is addressed by claims 1-8 and 24-25.

Applicant respectfully submits that the foregoing comprises a complete response to the Restriction Requirement of December 2, 2005. Entry and consideration of this response, toward further consideration and substantive examination of the application, are respectfully solicited.

Should anything further be required, a telephone call to the undersigned at (312) 456-8400 is respectfully requested.

Respectfully submitted,
GREENBERG TRAURIG, LLP

A handwritten signature in black ink, appearing to read 'Brad R. Bertoglio', written over a horizontal line.

Brad R. Bertoglio
One of Attorneys for Applicant


Dated: January 18, 2006



CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, pursuant to 37 C.F.R. §1.8, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date set forth below.

Dated: January 18, 2006



Brad R. Bertoglio